

ESTTA Tracking number: **ESTTA108105**Filing date: **11/06/2006**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Sterling Bank
Granted to Date of previous extension	01/17/2007
Address	3100 Route 38 Mount Laurel, NJ 08054 UNITED STATES
Attorney information	Roberta Jacobs-Meadway Ballard Spahr Andrews and Ingersoll, LLP 1735 Market Street, 51st Floor Philadelphia, PA 19103 UNITED STATES jacobsmeadwayr@ballardspahr.com, steigerwalte@ballardspahr.com Phone:215-864-8201

**Applicant Information**

Application No	75936977	Publication date	09/19/2006
Opposition Filing Date	11/06/2006	Opposition Period Ends	01/17/2007
Applicant	Sterling Bank and Trust, FSB One Towne Square 17th Floor Southfield, MI 48076 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 036. First Use: 1996/07/10 First Use In Commerce: 1996/07/10

All goods and services in the class are opposed, namely: Banking and financial services, namely, checking account services, savings account services, certificate of deposit services, individual retirement account (IRA) services, cash management account services, money market account services; providing safe deposit boxes, issuing official checks, currency exchange services, currency exchange information services, mortgage origination and servicing, lending services, loan application processing services, issuing letters of credit, electronic funds transfer services, providing on-line financial information, credit card services, credit reporting services, investment brokerage services, financial planning services, investment brokerage services, financial valuation of real estate, investment of funds for others, and investment consultation and management in the fields of securities, funds, mutual funds, commodities and capital

Attachments	NOO Sterling v Sterling.PDF ( 4 pages )(108489 bytes )
Signature	/Roberta Jacobs-Meadway/

Name	Roberta Jacobs-Meadway
Date	11/06/2006

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING  
TRANSMITTED ELECTRONICALLY TO THE COMMISSIONER FOR  
TRADEMARKS - <http://estta.uspto.gov/filing-type.jsp>

By: Valerie L. Moorman

DATE: 11/6/06

**BOX TTAB FEE**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Sterling Bank	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. _____
	:	
Sterling Bank and Trust, FSB	:	
	:	
Applicant.	:	

**NOTICE OF OPPOSITION**

Honorable Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

Dear Madam:

In the matter of Trademark Application Serial No. 75/936,977 for the mark  
STERLINGBANK.COM, filed March 6, 2000 and published for opposition in the Official  
Gazette on September 19, 2006:

Sterling Bank, a New Jersey state chartered bank having a place of business at 3100  
Route 38, Mount Laurel, NJ 08054 ("Opposer"), believes that it will be damaged by the  
registration of the mark shown in the above-identified application and hereby opposes the same.  
The grounds for opposition are as follows:

1. Sterling Bank and Trust FSB, a Federally chartered savings bank  
("Applicant"), seeks to register "STERLINGBANK.COM" as a trademark for use in connection

with banking and financial services, as evidenced by the publication of said mark in the Official Gazette on September 19, 2006.

2. The application herein opposed was filed March 6, 2000 on the basis of use. Applicant claims no date earlier than July 10, 1996 for the purpose of claiming priority.

3. Opposer is and has been engaged in the rendering of banking services.

4. Since at least as early as December 7, 1990, Opposer has used STERLING BANK as its name and mark for banking services.

5. Opposer has made application for registration of STERLING BANK & Design, application serial no.76/519,362 in the U.S. Patent & Trademark Office, and such application has been suspended pending disposition of the application herein opposed on the ground that there is a likelihood of confusion between the mark of the application herein opposed and the mark of Opposer's application.

6. Use of the STERLING BANK name and mark by Opposer has been continuous and commercially significant since at least as early as December 7, 1990.

7. Opposer's STERLING BANK name and mark are inherently distinctive as applied to Opposer's banking business and services.

8. By virtue of Opposer's continuous use in commerce of its STERLING BANK name and mark in connection with such business and services, such business and services have become well and favorably known to the relevant trade and public under such name and mark in the market area served by Opposer, principally New Jersey, Pennsylvania and Delaware.

9. In the application herein opposed, there are no restrictions on trade channels, so it must be assumed that the services identified in the application will travel through all trade channels appropriate for services of that type, to all geographic markets within the U.S.

10. Opposer's mark has been deemed by the Trademark Office Examining Attorney to be confusingly similar to Applicant's mark herein opposed. If and to the extent that there is likelihood of confusion, Opposer is the prior user of STERLING BANK for banking services.

11. Opposer's name and mark and Applicant's mark employ the identical term, "STERLING," as the dominant element.

12. The services of Opposer and the services of Applicant are essentially the same, banking services.

13. If and to the extent that Applicant's STERLINGBANK.COM trademark as applied to the services identified in the application herein opposed so resembles Opposer's STERLING BANK name and mark as used in connection with Opposer's business and services that it is likely to cause confusion, mistake, and/or deception, Opposer is the prior user and is entitled to register its mark.

14. If Applicant is permitted to register STERLINGBANK.COM for the services set forth in the application herein opposed, the Trademark Office has taken the position that confusion of the relevant trade and public is likely to result, and that Opposer's mark may not proceed to publication. This will damage and injure Opposer, to the extent that Opposer is unable to register its own mark.

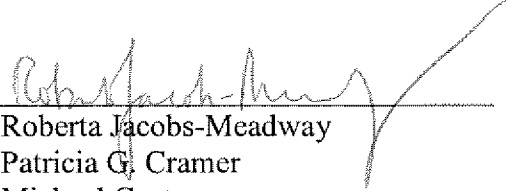
15. If Applicant is granted a registration for the mark herein opposed, it would obtain thereby at least a *prima facie* exclusive right to use the mark for the services identified in the application. Such registration would be a source of damage and injury to Opposer.

WHEREFORE, Sterling Bank prays that registration of the mark of Application Serial No. 75/936,977 be refused and that this opposition be sustained.

The required fee of \$300 may be charged to Deposit Account No. 02-0755 and any overpayment may be credited to this account.

Respectfully submitted,

Dated: 11/6/06

By:   
Roberta Jacobs-Meadway  
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Michael Costa  
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